REMARKS

Claims 1 to 25 are pending in the present application. Claims 1-25 are rejected. In addition, claim 24 is objected to. The disclosure is also objected to by the Examiner. Accordingly, the disclosure is herewith amended to overcome the objection. Additionally, the drawings are objected to for failure to comply with 37 CFR 1.84(p)(5). Corrected drawings are submitted herewith to overcome the objections. Finally, claims 1 and 24 are herewith amended and claims 6, 8, 23 and 25 are herewith deleted to assist in overcoming the objection and rejections. The amendments add no new matter.

The examiner rejected claims 6-9 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses this rejection.

Applicant uses the term "coarse" in claims 6 and 7 and "fine" in claims 8 and 9 to describe the claimed adjustment mechanisms. These terms and the associated mechanisms are well defined in the specification and in the drawings. The disclosure provides a "coarse" adjustment for both the horizontal and vertical axes as disclosed and claimed comprises an actuator having an insert and an adjustment bore. The adjustment bore includes a threaded lower region to engage a threaded guide and a non-threaded upper region sized to permit the movement of threaded guide through the upper region of the bore. The threads in the lower region of the adjustment bore comprise the entirety of the threads within the threaded bore such that when the coarse adjustment is in the disengaged position (see Fig. 3B), the threaded guide is free to move through the threaded bore. Through this mechanism the die frame is adjustable, as disclosed and claimed, along either the horizontal and vertical axes within the chase. This mechanism allows, by definition, a relatively large-scale movement of the die frame within the chase. Thus, applicant, as its own lexicographer, has selected the term "coarse" to describe this particular mechanism as defined in the disclosure.

Similarly, the "fine" adjustment for the die frame within the chase in the horizontal and vertical axes as disclosed and claimed comprises a worm gear in a gearing relationship with a spur gear. Under the invention, the rotation of the worm gear confers rotational movement to the spur gear resulting in rotation of the vertical or the horizontal threaded guide as appropriate. The rotation of the threaded vertical guide, e.g., results in adjustment of the die frame within the chase along the vertical axis, an adjustment that, by definition of the mechanism components, allows a much "finer" adjustment than the "coarse" adjustment

mechanism. Again, applicant has as its own lexicographer elected to utilize "fine" to describe this adjustment mechanism that is capable of more precise positioning of the die within the chase than the "course" adjustment mechanism and as defined by the disclosure.

The specification further discloses that, in use, the die is initially, and roughly, positioned both horizontally and vertically using the "coarse" adjustment. Further refinement of the die position is obtained using the "fine" vertical and horizontal adjustment mechanism until the required positional precision is achieved. Applicant asserts that the disclosure and claims are adequate for apprising one skilled in the art of the degree of difference between such a "coarse" adjustment and a subsequent "fine" adjustment whereby the die is first roughly positioned within the chase and then ultimately precisely positioned.

Accordingly, applicant respectfully requests the Examiner withdraw the rejection of claims 6-9 under 35 U.S.C. § 112, second paragraph as being indefinite.

The examiner rejects claims 1, 6, and 8 under 35 U.S.C. 102(b) as being anticipated by Ginsburg, U.S. Patent 921,974. Applicant traverses this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[1] If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.[2]

A reference must teach or suggest all elements of a claim to anticipate the claim. In claim 1 as amended, applicants disclose and claim an apparatus for adjusting a die of a printing press, comprising *inter alia*, a chase defining a vertical axis and a horizontal axis, a die frame slidably secured to the chase to allow adjustment of the die frame in the vertical axis and the horizontal axis of the chase, at least one of a coarse vertical adjustment and a coarse horizontal adjustment, and at least one of a fine vertical adjustment and a fine horizontal adjustment.

In contrast, Ginsburg discloses a chase A with die frame B adapted to be set within chase A. Set screws A' are used to engage the sides of the chase for locking the frame in place and for adjusting the frame and chase relative to each other. Ginsburg does not claim, nor does the disclosure suggest, the combination of coarse and fine slidable positioning of the frame within the chase. Rather, Ginsburg in claim 2 employs means plus function language,

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[1] MPEP Sec. 2142.

[2] Id.

i.e., "means on the margins of the chase for locking the chase in place, and adjusting the frame and the chase with relation to each other." Case law interpreting means plus function language requires that only the particular apparatus disclosed may be considered to fall within the scope of the claim, without equivalents. Here, the specification discloses only one apparatus for such locking and adjusting of the frame with respect to the chase, that is, set screws. This implies a finite number of positions that the frame may take with respect to the chase. In contrast, applicant's invention allows for the slidable adjustment and securing of the frame to the chase at any point within the frame and is not limited to a set number of positions as indicated in Ginsburg.

Thus, Ginsburg fails to teach or suggest the combination of coarse and fine slidable adjustment of the frame within the chase.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 6 and 8 under 35 U.S.C. 102(a) as anticipated by Ginsburg.

The examiner rejects claims 1-5, 7, 9, 10, 12, 17, 18 and 23-25 under 35 U.S.C. 103(a) as obvious over Bolles, U.S. Patent 1,144,458 in view of Gibbs, U.S. Patent 5,000,544. Applicant respectfully traverses the §103 rejection because the office action has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully request that the Examiner withdraw the rejection of the claims.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."[3]

As admitted by the Examiner, neither Bolles nor Gibbs alone teaches or suggests all the claim limitations as amended. Further, there is no suggestion or motivation in either Bolles or Gibbs to combine the references. In fact, one skilled in the art of improving the adjustability of printing press dies would simply not be motivated to refer to Gibbs wherein

[3] Id.

the Abstract provides that the invention relates to "[a]n assembly for use with an optical microscope in visually detecting the presence of a microscopic object in a sample and determining the position of the object in the sample . . . ."and the Background indicates that "[t]his invention relates to an apparatus for making investigations with microscopes." (Page 1, lines 9-10.) Even assuming *arguendo* that the references may be combined, neither reference discusses the concept of "coarse" adjustment mechanism in combination with a "fine" adjustment mechanism.

As noted above, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." The Examiner has not shown where the prior art teaches or suggests making the claimed combination or a reasonable expectation of success. Finally, the examiner has not applied the test of *Graham v. John Deere*[4] The MPEP requires the Examiner to do so.[5] Nor has the Examiner has made a finding of the level of ordinary skill in the art.[6]

Claim 1 as amended contains elements or limitations beyond the cited references and is therefore not obvious in view of either Bolles or Gibbs or the combination thereof. Claims 2-5, 7, 9, 10, 12, 17 and 18 depend from claim 1, rendering said claims non-obvious in view of Bolles or Gibbes or the combination thereof. Claims 23 and 25 are herewith deleted. Claim 24 is herewith amended to add the combination of "coarse" and "fine" adjustment lacking in both Bolles and Gibbs as well as the combination thereof.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-5, 7, 9, 10, 12, 17 and 18, and 23-25 under 35 U.S.C. 103(a) as obvious in view of Bolles and Gibbs.

The Examiner further rejects claims 11, 13 and 19 under 35 USC 103(a) as obvious over Bolles in view of Gibbs as applied to claims 1-5, 7, 9, 10, 12, 17, 18 and 23-25 and, further in view of Posh, U.S. Patent 3,449,971. Applicant respectfully traverses the §103 rejection because the office action has not established a *prima facie* case of obviousness.

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[4] 383 U.S. 1,148 USPQ 459 (1966)

[5] MPEP § 2141

[6] MPEP § 2141.03

As discussed above, claims 1-5, 7,9,10, 12, 17 and 18, and 24 as amended, contain limitations that are not disclosed in either Bolles or Gibbs or a combination thereof. Nor is there a suggestion or motivation to combine the two references.

Similarly, with respect to the impermissible combination of Bolles/Gibbs in further view of Posh, none of the references teach, nor does the combination thereof suggest, all elements of the relevant claims 11, 13 and 19. Further, there is no suggestion to combine the references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of the claims.

As the Examiner concedes, neither Bolles, Gibbs nor Posh alone teaches or suggests all the claim limitations as amended. Further, there is no suggestion or motivation to combine the references. Even assuming *arguendo* the impermissible combination of Bolles with Posh, it would not be obvious to one skilled in the art to include a "coarse" adjustment mechanism in combination with a "fine" adjustment mechanism as in the amended claims.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 11, 13 and 19 under 35 U.S.C. 103(a) as obvious in view of Bolles and Gibbs and in further view of Posh.

The Examiner rejects claims 14-16 and 20-22 under 35 USC 103(a) as obvious over Bolles in view of Gibbs as applied to claims 1-5, 7, 9, 10, 12, 17, 18 and 23-25 above, and further in view of Gortner, U.S. Patent 6,598,868. Applicant respectfully traverses the §103 rejection because the office action has not established a *prima facie* case of obviousness.

As discussed above, claims 1-5, 7,9,10, 12, 17, 18 and 24, as amended, contain limitations that are not disclosed in either Bolles or Gibbs or a combination thereof. Nor is there a suggestion or motivation to combine the two references.

Similarly, with respect to the impermissible combination of Bolles/Gibbs in further view of Gortner, none of the references teach, nor does the combination thereof suggest, all elements of the relevant claims. Further, there is no suggestion to combine the references. Even assuming *arguendo* the propriety of such combination, there is no teaching or suggestion in any of the references regarding a combination of "coarse" adjustment with "fine" adjustment. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of the claims.

In view of Applicant's amendments and remarks, the specifications and claims are believed to be in condition for allowance. Reconsideration, withdrawal of the rejections, and

passage of the case to issue is respectfully requested. If any fees not accounted for above are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 02-3732.

Respectfully submitted,

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By _____

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